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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/719,969	11/21/2003	Akira Arai	9319A-222DVA	3570

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EXAMINER

SHEEHAN, JOHN P

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 03/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/719,969	Applicant(s) ARAI ET AL.	
	Examiner John P. Sheehan	Art Unit 1742	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 17-23 and 35-38 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 17-23 and 35-38 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 November 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☒ Certified copies of the priority documents have been received in Application No. 09/871,600.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>7/04 10/04 5/05 2/5 10/5</u> | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Specification

1. The Examiner objects to the first paragraph of the specification, added by the Preliminary Amendment submitted November 21, 2003, in that the paragraph does not state the current status of the parent application.

Claim Objections

2. Claims 17, 19, 20, and 35 are objected to because of the following informalities:
 - I. The Examiner objects to claim 17, lines 4 and 5; claim 19, lines 4 and 5; claim 20, line 3; and claim 35, lines 3 and 4; in that the meaning of the phrase, "kind of rare earth" is not clear. It is not clear what constitutes a "kind" of rare earth, that is, what makes one rare earth a different "kind" from another rare earth. This objection can be overcome by deleting each occurrence of "kind of".
 - II. In claim 17, line 4, the term "CR" is the incorrect symbol for chromium (Cr).

Appropriate correction is required.

Claim Rejections - 35 USC § 102/103

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

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(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 17 to 23 and 35 to 38 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Hamano et al. (Hamano, Japanese Patent Document No. 11-288807, cited by applicants in the IDS submitted November 21, 2003).

Hamano teaches specific examples of bonded magnets that are encompassed by the bonded magnet composition recited in the instant claims (see translation, Table 2, Alloy Nos. 22 to 27). These alloys are comminuted to a particle size of 34 to 93 microns (Table 4, column 5). The resulting powders are made into bonded magnets (translation, paragraph 0136) having coercivity values in the range 453.6 to 506.3 (translation, Table 5, Alloy Nos. 23 to 27) that are encompassed by the coercivity range of 430 to 750 kA/m recited in applicants' claims. Hamano also teaches that the alloy powder possess magnetically hard and soft phases (translation, paragraph 0126). Hamano teaches a method of making the alloy powder that appears to be the similar if not the same as applicants' disclosed process of making the instant claimed powder (compare translation, paragraphs 0105 to 0109 to the instant specification, paragraphs 0092 to 0095).

Hamano and the claims differ in that Hamano is silent with respect to the properties recited in the instant claims.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the specific example alloys taught by Hamano have compositions and bonded magnet coercivity values that

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are encompassed by the instant claims and are made by a process that is similar to, if not the same as, applicants' process. In view of this, the alloy taught by the reference would be expected to possess all the same properties as recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, In re Best, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' In re Spada, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. In re Best, 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 17 to 23 and 35 to 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over each of Panchanathan (Panchanathan, US Patent No. 5,72,792, cited in the IDS submitted November 21, 2003) or Mohri et al. (Mohri, US Patent No. 4,765,848, cited in the IDS submitted November 21, 2003).

Each of the references teaches a magnetic powder for use in bonded magnets (for example, see Panchanathan, Abstract and Mohri, column 10, Example 4) having a composition that overlaps the alloy composition recited in the instant claims (Panchanathan, column 1, lines 37 to 50 and Mohri, column 3, lines 30 to 42 and column 5, lines 5 to 30). Each of these references also teaches a process of making the disclosed magnetic powder and a bonded magnetic made of magnetic powder that is similar to the process disclosed in the instant application (Panchanathan, column 2, lines 1-21 and Mohri, column 5, lines 45 to 50). Panchanathan teaches the presence of a hard and soft magnetic phase (column 1, lines 50 to 57).

The claims and the references differ in that the references do not teach the exact same alloy composition and are silent with respect to the claimed magnetic properties.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the powder alloys and the bonded magnets made from the disclosed powder alloys taught by the references have compositions that overlap the bonded magnet composition recited in the instant claims and therefore are considered to establish a prima facie case of obviousness, In re Malagari, 182 USPQ 549 and MPEP 2144.05. Further, in view of the fact that the alloys and the bonded magnets taught by Panchanathan and Mohri are made by a process which is similar to, if not the same as, applicants' process of making the powder alloys and the instantly bonded magnets, the bonded magnets taught by Panchanathan and Mohri would be expected to possess all the same properties as recited in the instant claims, In re Best, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' *In re Spada*, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977)." (emphasis added by the Examiner), see MPEP 2112.01.

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 17 to 23 and 35 to 38 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 17 to 22 and 34 to 36 of copending Application No. 10/719,250. Although the conflicting claims are not identical, they are not patentably distinct from each other because the bonded magnet compositions recited in these two sets of claims are

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exactly the same. The only difference in these two sets of claims is a difference in the claimed magnetic properties.

However, one of ordinary skill in the art at the time the invention was made would have considered the invention to have been obvious because the bonded magnet compositions in the two sets of claims are exactly the same and are made by the same process. In view of this, the claimed alloys would be expected to possess all the same properties, *In re Best*, 195 USPQ, 430 and MPEP 2112.01.

"Where the claimed and prior art products are identical or substantially identical in structure or composition, or are produced by identical or substantially identical processes, a prima facie case of either anticipation or obviousness has been established, *In re Best*, 195 USPQ 430, 433 (CCPA 1977). 'When the PTO shows a sound basis for believing that the products of the applicant and the prior art are the same, the applicant has the burden of showing that they are not.' *In re Spada*, 15 USPQ2d 655, 1658 (Fed. Cir. 1990). Therefore, the prima facie case can be rebutted by evidence showing that the prior art products do not necessarily possess the characteristics of the claimed product. *In re Best*, 195 USPQ 430, 433 (CCPA 1977)." see MPEP 2112.01.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

9. Claims 17 to 23 and 35 to 38 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 12 to 18 of US Patent No. 6,627,102. Although the conflicting claims are not identical, they are not patentably distinct from each other because the alloy compositions recited in each of these applications overlap when M is Dy in the instant set of claims.


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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John P. Sheehan whose telephone number is (571) 272-1249. The examiner can normally be reached on T-F (6:45-4:30) Second Monday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on (571) 272-1244. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9306 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1700.


John P. Sheehan
Primary Examiner
Art Unit 1742

jps
March 12, 2006